

### **REMARKS**

The Office Action mailed April 29, 2005 has been carefully reviewed and, in view of the above amendments and following remarks, reconsideration and allowance of the application are respectfully requested.

#### **I. Summary of Claims**

Claims 1-8, 10-14, 27-34, and 41-49 are currently pending in the application, with claims 1, 27, 41, and 49 being independent claims. Claims 1, 41, and 42 are amended in accordance with the above amendments, and claims 9, 15-26, and 35-40 are cancelled.

#### **II. Summary of Rejections**

The following claim rejections were submitted by the Examiner in the outstanding Office Action:

- Claims 1-3, 5-7, 11-14, 27, 29-32, 41, and 43-48 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 5,647,150 to Romanato, et al.;
- Claims 4, 28, and 42 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Romanato and either of U.S. Patent Number 4,785,558 to Shiomura and U.S. Patent Number 4,232,458 to Bartels; and
- Claims 8-10, 33, and 34 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Romanato and U.S. Patent Number 3,650,051 to Sass.

#### **III. Discussion of U.S. Patent Number 5,647,150 to Romanato, et al.**

Romanato discloses an article of footwear having a sole 2 and an upper 3. The primary elements of upper 3 are a sock 4 and a thermoplastic material 5 and/or 11. The Applicants wish to point out that reference numerals 5 and 11 appear to refer to the same thermoplastic material. As depicted in Figure 6, sock 4 is formed from three layers that include a grid-like sheet 8, a thermoplastic film 9, and a protective fabric 10. According to Romanato, sheet 8 may be formed of "a material that can be of various kinds (polyester, EVA, leather, metal, or others) provided that it has a grid-like structure and can be coextruded with a film 9 of thermoplastic material (polyurethane, polyethylene, nylon, or others) which may have any weight per unit volume,

provided that it is compatible with the thermoplastic material [11] which will be subsequently injection-molded in place..." (Romanato, column 2, lines 47-54).

Following the formation of sock 4, thermoplastic material 5 and 11 is injection molded to sock 4. Thermoplastic material 5 and 11 flows "through the holes formed in the grid-like sheet 8, during the injection-molding step. Cohesion is thus produced due to melting between this material and the material of the thermoplastic film 9 which lies below the sheet 8, as shown in FIG. 7, where the molded-in-place thermoplastic material is designated by the reference numeral 11; this cohesion ensures the tight mutual coupling of the two components, namely the sock or portion thereof and the shell or upper" (Romanato, column 3, lines 1-10).

With reference to Figure 3, various openings 6 may be formed in thermoplastic material 5 and 11, thereby exposing sock 4. More particularly, openings 6 form apertures in thermoplastic material 5 and 11 that expose both of sheet 8 and film 9.

#### **IV. The Claims Patentably Distinguish Over The Applied Prior Art**

##### ***Discussion of Independent Claim 1***

Independent claim 1 recites an article of footwear having an upper and a sole structure secured to the upper. At least a portion of the upper includes a substrate layer and a web layer. The substrate layer is formed of an air-permeable textile material at least partially formed from a plurality of filaments or fibers. The web layer defines a plurality of apertures that expose portions of the textile material of the substrate layer. The web layer is formed of a polymer material that infiltrates the textile material of the substrate layer and extends around the plurality of filaments or fibers to secure the web layer to the substrate layer.

The Office Action states analogizes sheet 8 and/or sock 4 of Romanato to the substrate layer of independent claim 1. Furthermore, the Office Action analogizes upper 3 and/or material 11 to the web layer of independent claim 1. Referring to Figure 7, sheet 8 includes a plurality of apertures and material 11 extends into the apertures. According to Romanato:

The use of a material according to the composition shown in FIG. 6 for the sock or for part thereof allows to achieve optimum anchoring of said sock or sock portion to the shell or upper 3, by virtue of the flow of injected thermoplastic material which occurs through the holes formed in the grid-like sheet 8, during the

injection-molding step. Cohesion is thus produced due to melting between this material and the material of the thermoplastic film 9 which lies below the sheet 8, as shown in FIG. 7, where the molded-in-place thermoplastic material is designated by the reference numeral 11; this cohesion ensures the tight mutual coupling of the two components, namely the sock or portion thereof and the shell or upper. (Romanato, column 2, line 65 through column 3, line 10)

Accordingly, Romanato teaches the concept to material 11 flowing through grid-like apertures in sheet 8 and bonding to film 9.

In contrast with Romanato, independent claim 1 recites that the polymer material of the web layer infiltrates the textile material of the substrate layer and extends around the plurality of filaments or fibers to secure the web layer to the substrate layer. That is, independent claim 1 recites a mode of securing two elements together that is not taught or suggested by Romanato. In order for a reference to anticipate a claim, the reference must teach each and every element of the claimed invention. In this matter, Romanato does not teach or suggest a polymer material that infiltrates a textile material and extends around the plurality of filaments or fibers of the textile material to secure the polymer material to the textile material.

Based upon the above discussion, the Applicants respectfully submit that independent claim 1 is allowable over Romanato. In addition, claims 2-8 and 10-14 should all be allowable as neither of Shiomura, Bartells, nor Sass remedy the deficiency of Romanato.

#### *Discussion of Independent Claims 27 and 41*

Each of independent claims 27 and 41 also recite the concept of a polymer material that infiltrates a textile layer and extends around fibers and/or filaments to secure the polymer layer to the textile layer. Accordingly, each of independent claims 21 and 41 should be allowable for at least the same reasons as independent claim 1. In addition, claims 28-34 and 42-48 should all be allowable as neither of Shiomura, Bartells, nor Sass remedy the deficiency of Romanato.

#### *Discussion of Independent Claim 49*

Independent claim 49 substantially includes the recitations of each of claims 1, 5, 8, and 9 prior to the present Amendment. During an interview with the Examiner, the subject of claim 9

was discussed and the Examiner indicated that a combination of these claims may be allowable. Accordingly, the Applicants respectfully submit that independent claim 49 is allowable over the prior art of record.

#### V. Conclusion

In view of the foregoing, the Applicants respectfully submit that all claims are in a condition for allowance. The Applicants respectfully request, therefore, that the rejections be withdrawn and that this application now be allowed.

This Amendment is being timely filed by facsimile transmission on July 12, 2005. Should additional fees or an extension of time be deemed necessary for consideration of this Amendment, such fees or extension are hereby requested and the Commissioner is authorized to charge deposit account number 19-0733 for the payment of the requisite fee. If anything further is desirable to place the application in even better form for allowance, the Examiner is respectfully requested to telephone the undersigned representative at (503) 425-6800.

Respectfully submitted,

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